

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF APPEALS

#13
Walden
11-6-03

In re Application of

Robert Skvorecz :

Reissue of US Patent 5,996,948

EXAMINER: Tan Le

SERIAL NO: 09/772,278 :

: GROUP: 3632 :

FILED: March 15, 2001 :

FOR: WIRE CHAFING STAND :

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GROUP 3600

BRIEF FOR APPELLANT

Hon. Commissioner of Patents
and Trademarks
Washington D.C. 20231

SIR:

All necessary fees in connection with this Appeal Brief should be deducted
from Deposit Account No. 01-1944.

(1) Real Party In Interest:

Robert Skvorecz, as appellant, is currently the real party in interest.

(2) Related Appeals and Interferences:

There is no related appeal or interference proceeding.

(3) Status of Claims:

Claims 1-7 are pending in the application. The Claims are set forth in the
Appendix attached hereto and made a part hereof.

(4) Status of Amendments Filed Subsequent to Final Rejection:

No amendments to the claims were filed subsequent to the final rejection.

(5) Summary Of Invention

The invention relates to a wire chafing stand which is a mechanical structure for supporting pre-cooked food at a remote location relative to where the food is cooked. The remote location is typically an outdoor location where an event such as a party or barbeque is to be held. The wire chafing stand supports a warming pan, preferably of aluminum, into which the pre-cooked food is placed. A burner, referred to as a chafing fuel heater, may be placed under the pan to keep the food warm.

A wire chafing stand is constructed of wire rod steel and assembled using a conventional fixture bending jig into a chafing stand which will support the warming pan. Accordingly, it is inexpensive to manufacture a wire chafing stand. However, in direct comparison, the cost of transporting wire chafing stand's relative to their cost is significant. This is attributable to the size of each fully assembled wire chafing stand and to the volume of space which a fully assembled wire chafing stand occupies. To minimize the cost of transporting wire chafing stands it is desirable that they be packaged in a container nested into one another with the expectation of the customer separating them upon delivery. However, nesting tends to cause the wire chafing stands to wedge into one another making it difficult for the stands to be separated without causing significant damage not to mention the difficulty of separating wedged stands if at all possible.

The present invention, which issued as US Patent No. 5,996,948 is directed to a solution to the problem of nesting multiple wire chafing stands at minimal risk of wedging and to a solution facilitating their separation.

The wire chafing stand of the subject reissue patent application is constructed from wire rod steel and includes an upper rim which forms a closed geometrical configuration circumscribing an area preferably of rectangular geometry adapted to

accommodate a warming pan and a pair of wire legs which support the upper rim . In the preferred embodiment a lower rim is shown located below the upper rim for use as a lower tray to support one or more chafing fuel heaters.

The solution to the problem of nesting, upon which the parent application was allowed, is attributable to the novel arrangement of "offsets" either in the upper rim or in the upright section of the wire legs. The offsets are explained on pages 7 and 8 in the detailed description of the patent specification and cause lateral displacements of each side of each wire leg to enable the wire legs of one chafing stand to nest within another chafing stand without interference thereby preventing wedging.

DISCOVERY OF ERROR IN US PATENT No. 5,996,948

After issuance of US Patent No. 5,996,948 applicant, in a discussion with the attorney of record relative to the scope of the issued patent, stated to the attorney of record that the lower rim is preferred but is not essential to the construction of the wire chafing stand. Moreover, the lower rim is completely unrelated to the nesting problem and is not significant to the construction of the wire chafing stand. Claim 1 of US Patent No. 5,996,948, representing the broadest claim in terms of its scope, limits the wire chafing stand to a construction having a lower rim. Accordingly, it was an error to include in claim 1 of US Patent No. 5,996,948 the recitation of a lower rim. This served as the basis for filing of the subject reissue application under 37 CFR 1.63, in a period of time within two years of the issue date, claiming that the original patent was wholly or partially inoperative by reason of applicant claiming less than applicant had a right to claim. In the subject reissue application, claim 1 was amended, to remove the recitation of the lower rim.

(6) Concise Statement Of Issues

1. Claims 1-5 and 7 stand finally rejected "as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based" under 35 USC 251. Claim 6 is an independent claim which is identical to claim 6 in the issued patent and is again reallowed.

2. The sole issue in this appeal is whether claim 1 of the reissue application violates the recapture rule under 35 USC 251 preventing applicant from broadening claim 1 as originally issued to correct the error.

(7) Grouping Of Claims

Claims 1-5 and 7 have been grouped together and rejected as one. Accordingly, the allowance of claims 1-5 and 7 in this reissue application stand or fall together.

(8) Argument

The final rejection is based upon the recapture rule under 35 USC 251 which has been interpreted by the Examiner as being a test to determine if changes were made in the claims during prosecution of the parent patent application involving in any way the removed wording from the broadened reissue claim and if indeed changes were made and the changes involved in any way the removed wording from the reissue claim then by definition (independent of substance) the reissue claim becomes automatically an attempt to improperly claim that which was surrendered during prosecution and is invalid under 35 USC 251. This application of the recapture rule under 35 USC 251 has been reduced by the Examiner to a mechanical word comparison between the reissue claim and the wording of the claims during prosecution of the parent application to see if words were changes and if the changed wording related, in any way, to the removed wording from the reissue claim. No technical

consideration was given at all to the substance of the changed wording during prosecution or to determine its relationship to surrendered subject matter.

The Examiner located an amendment in the parent patent application filed on July 26, 1999. On Page 3 of the final rejection the Examiner makes reference to this prior amendment and states that the originally filed wording of claim 1 in the parent patent application had been changed from " a pair of wire legs of equal length affixed at one end thereof to the upper rim and affixed to the lower rim at an equal location substantially approximate the opposite end of each wire leg such that the upper rim and lower rim lie in substantial parallel alignment to one another with the wire legs extending equal distances below the lower rim to uniformly support the stand at opposing ends thereof and have a plurality of offsets in the upper rim of said stand or in the wire legs at the point of interconnection therebetween" to read - - "a plurality of wire legs with each wire leg having two upright sections interconnected to one another at a location below the lower rim in a configuration forming a base support for the stand to rest upon with each upright section extending upwardly from said base support to form an angle equal to or greater than 90 degrees with respect to a horizontal plane through said base support and being affixed to the upper rim adjacent one end thereof and to said lower rim at a relatively equal distance below the point of attachment to said upper rim and further comprising a plurality of offsets located either in said upright sections of said wire legs or in said upper rim for laterally displacing each wire leg relative to said upper rim to facilitate the nesting of a multiplicity of stands into one another without significant wedging". The original application was allowed and issued based upon the changed wording.

Upon making the above noted comparison, the Examiner concluded that changes were made to the original claim 1 in the parent application to overcome prior art and that the revised wording *includes a reference to the lower rim* (emphasis added).

Accordingly, based upon the above mechanical test of the recapture rule, removal of the lower rim limitation in the reissue claim automatically invokes recapture.

The fact that the same Examiner had rejected the originally worded claim 1 as being fully anticipated under 35 USC 102 is not considered relevant to the above mechanical test of the recapture rule. It was not denied by the Examiner that the lower rim and its location in the chafing stand relative to the upper rim and to the wire legs was known and taught in the prior art and acknowledged as such by applicant. This too is not considered relevant to the above mechanical test of the recapture rule. In fact, the revised wording of claim 1 revises the wording to use the lower rim only as a point of reference and the scope of the limitation is not changed from its scope in the original claim. No arguments were made by applicant regarding the lower rim to overcome the prior art and the Examiner allowed the application over rejections under 35 USC 103 based upon the non-obviousness of the relationship of "offsets" to the wire legs or to the upper rim and to the function of the offsets. The lower rim was never alleged by applicant to distinguish over the prior art and the Examiner maintained his position that the lower rim lacks novelty throughout the prosecution. Furthermore, the Examiner makes no attempt to explain or discuss the subject matter surrendered during the prosecution.

Applicant maintains that the recapture rule is not a rule to be mechanically applied. Moreover, a mechanical application of the recapture principal is not supported by case law or by the MPEP and is inconsistent with 37 CFR 1.63 which specifically permits a reissue application to be filed within two years of the date of issue to broaden the claims of the original patent. By definition a broadened reissue claim has broader language than its issued counterpart. Therefore to determine if recapture is to apply to prevent the applicant from regaining subject matter surrendered, it is incumbent upon the Examiner to define the subject matter surrendered during prosecution and not to simply make a comparison between

words using an argument based solely on a word comparison independent of reference to the prosecution and / or cited prior art during the prosecution.

Applicant maintains that 37 CFR 1.63 permits applicant to file a broadened reissue claim to correct an error in the application. The modification of the lower rim recitation to the original claim language during prosecution was **not substantive** (emphasis added) and in fact the limitation relative to the lower rim was the same or reduced in scope. Moreover, the lower rim and the construction of a chafing stand with a lower rim was well known to the prior art and the lower rim limitation was not relevant to overcome the prior art. Accordingly, the lower rim limitation is not **directly pertinent** (substantively) to the subject matter surrendered during prosecution and, as such, the recapture rule under 35 USC 251 does not apply in this case.

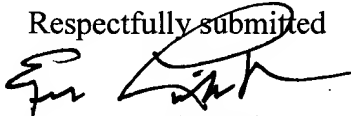
The Examiner has also noted that in the Notice Of Allowability the Examiner recited the entire allowed claim inclusive of all the amended language as a basis for the allowance and that applicant did not submit a response to request correction of the statement of the Examiner. Somehow the Examiner believes that applicant is now precluded from filing a reissue application because applicant failed to request correction of the statement of the Examiner. No basis exists in the MPEP or in case law in support of this theory and applicant does not consider this allegation to have any merit. Moreover, since the Examiner recites all of the allowed claim language without distinction the statement of the Examiner bears no relevance on what individual features distinguish over the prior art.

The Examiner also has referred on page 7 of the final rejection to a statement of applicant during the prosecution which paraphrases the language of claim 1 in the parent application. The Examiner concludes from this that since claim 1 refers to the lower rim in the revised language that its inclusion in the reissue claim is a mandatory requirement of claim 1. If so, a broadening reissue applicant removing such language would never be

(9) **Conclusion**

The Examiner has clearly failed to substantiate invalidity of the reissue claims under the recapture rule in 35 USC 251. Accordingly, Applicant respectfully solicits the Board of Patent Appeals to reverse the final rejection of claims 1-7.

Respectfully submitted


Eugene Lieberstein
Reg. No. 24645

MAILING CERTIFICATE

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, MAIL STOP APPEAL BRIEF – PATENTS, on October 24, 2003.



Date: Oct. 24, 2003

APPENDIX

Claims:

1. (Amended) A wire chafing stand comprising a first [an upper] rim of wire steel which forms a closed geometrical configuration circumscribing a first surface area, [a lower rim of wire steel forming a closed geometrical configuration circumscribing a second surface area with said first surface area being larger than said second surface area] and having at least two [a plurality of] wire legs with each wire leg having two upright sections interconnected to one another [at a location below the lower rim] in a configuration forming a base support for the stand to rest upon with each upright section extending upwardly from said base support to form an angle equal to or greater than 90° with respect to a horizontal plane through said base support and being affixed to the first [upper] rim adjacent one end thereof [and to said lower rim at a relatively equal distance below the point of attachment to said upper rim] and further comprising a plurality of offsets located either in said upright sections of said wire legs or in said first [upper] rim for laterally displacing each wire leg relative to said first [upper] rim to facilitate the nesting of a multiplicity of stands into one another without significant wedging.

2. A wire chafing stand as defined in claim 1 wherein said plurality of offsets are in said upright sections and divide each upright section into two segments lying in different planes relative to one another.

3. (Amended) A wire chafing stand as defined in claim 7 [2] wherein said first and second rim [upper and lower rims] form a geometry selected from the class consisting of square, oval and rectangular configurations.

4. A wire chafing stand as defined in claim 3 wherein said wire legs support said stand from opposite sides thereof with each wire leg having a unitary construction and having two generally "U" shaped sections extending between an intermediate section defining a handle for the stand.

5. A wire chafing stand as defined in claim 1 wherein said plurality of offsets are welded to said wire legs at the separation of the upright sections into segments.

6. A wire chafing stand comprising an upper rim of wire steel which forms a closed geometrical configuration circumscribing a first surface area, a lower rim of wire steel forming a closed geometrical configuration circumscribing a second surface area with said first surface area being larger than said second surface area and having two wire legs for supporting said stand at opposite ends thereof with each wire leg being of unitary construction having two upright sections of substantially equal length with the upright sections being interconnected to one another in a generally "U" shaped configuration below said lower rim to form a base support for the stand to rest upon and being interconnected to one another adjacent the upper rim for defining a handle for the wire chafing stand and being welded at predetermined locations to the upper and lower rims such that the upper and lower rims lie in substantial parallel alignment to one another and with each upright section extending upwardly from the base support to form an angle equal to or greater than 90° with respect to a horizontal plane through said base support and further comprising a plurality of offsets located in said upright sections of said wire legs which separate the upright sections into segments lying in different planes relative to one another for laterally displacing each wire leg relative to said upper rim so as to facilitate the nesting of a multiplicity of stands into one another without significant wedging.

7. (New) A wire chafing stand as defined in claim 1 further comprising a second rim of wire steel located below said first rim with said second rim circumscribing a second surface area smaller than said first surface area and with said upright sections being affixed to said second rim at a relatively equal distance below their attachment to the first rim.